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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,106	11/09/2001	Paul A. Crawford	FMCC:014USR1	6485

7590

09/03/2002

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EXAMINER

NICHOLSON, ERIC K

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 09/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,106

Applicant(s)

CRAWFORD, PAUL A.

Examiner

Eric K Nicholson

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 11-09-01 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the unnumbered “retainer ring” discussed in the remarks and shown as a separate element and positioned on the outer diameter of the tube. The changes made to the lead lines appear to be acceptable for approval however the examiner disagrees with applicant’s statement that “support for the amendment to FIG. 1 adding the retainer ring is found in the originally-filed FIG.1”, the examiner can find no such “retainer ring” in the figure nor does the specification support the addition of this “retainer ring”.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's prior art figures 1 and 2 in view of Drawing no. 3254736 listed in the form 1449 and U.S. patent 5,350,205 to Aldridge et al.. The prior art figures 1 and 2 illustrate applicant's claimed invention with a pup joint having a length of pipe **12** having an outside diameter; an integrally formed female sub **16** connected to a first end of the length of pipe, the female sub **16** including a conical sealing surface **20**, an outer surface formed adjacent the conical sealing surface and external threads **22** formed on the outer surface; an integrally formed male sub **14** connected to the distal end of the length of pipe, the male sub **14** including a section having an outside diameter greater than the outside diameter of the length of pipe, the male sub also including a forward shoulder **32** extending radially outwardly there from and a spherical sealing surface **18** adjacent the forward shoulder which is adapted to mate with and seal against the conical sealing surface of another such pup joint; a nut **24** having an internal surface, internal threads **26** formed on the internal surface and a rearward shoulder **30** extending radially inwardly from the internal surface; one or more retainer segments **28** positioned between the rearward shoulder **30** of the nut and the forward shoulder **32** of the male sub for restricting axial movement of the nut relative to the male sub in a first direction. According to prior art Fig. 2 in the specification the male sub can be

threaded onto the distal end of the length of pipe, and the female sub can be threaded onto the first end of the length of pipe. The prior art figures 1 and 2 do not show a retainer ring in a groove nor a retention shoulder on the pipe length however, **Drawing no. 3254736** illustrates and teaches a similar end connection to that of prior art figures 1 and 2 and makes it known that it is old and well known to use a retainer ring **5** positioned in a corresponding groove formed in the retainer segments **4** and which has an outer diameter which is greater than the diameter of the rearward shoulder to thereby maintain the nut **2** positioned around the retainer segments **4** and **U.S. patent 5,350,205 to Aldridge** also illustrates and teaches a similar end connection to that of prior art figures 1 and 2 and shows also that it is old and well known to provide a retention shoulder **74** extending radially outwardly from the section of the male member the retention shoulder positioned rearwardly of the forward shoulder of the nut to restrict axial movement of the nut along the tube, see column 7, lines 4-9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the retainer segments **28** of the prior art fittings of figures 1 and 2 with the groove and retainer ring as taught by Fig. 3254736 for the purpose of keeping the nut on the retainer segments in order to keep the nut on the segments and thereby keep the segments together and on the length of pipe. Further, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to provide the length of pipe with a retention shoulder such as taught by shoulder 74 of U.S. patent 5,350,205 to Aldridge in order to limit the range of slidable movement of the coupling nut and retainer segments. See column 7, lines 4-9. As to claims 3,7 and 11 whether the shoulder is “machined” on to the pipe length or not is considered to be merely a process limitation and a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

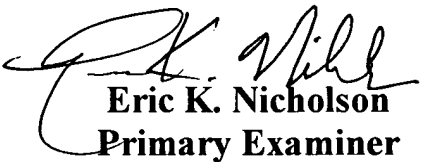
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne, can be reached on (703) 308-1159. The fax phone number for Technology Center 3600 is (703) 872-9326 for "before final" papers and (703) 872-9325 for "after final" papers.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

ekn
8/28/02


Eric K. Nicholson
Primary Examiner
Technology Center 3600